



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/103,072 | 06/23/1998 | CSABA TRUCKAI | ENVS-220 | 2603 |

7590 09/29/2003

KATHLEEN A. FROST
STALLMAN & POLLOCK LLP
121 SPEAR STREET
SUITE 290
SAN FRANCISCO, CA 94105

| |
|----------|
| EXAMINER |
|----------|

LAM, ANN Y

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

1641

DATE MAILED: 09/29/2003

26

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/103,072

Applicant(s)

TRUCKAI ET AL.

Examiner

Ann Y. Lam

Art Unit

3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 September 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-7, 15 and 34-95 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 34, 38-43, 45, 49-54, 58, 62-67 and 75-80 is/are allowed.
- 6) ☒ Claim(s) 5-7, 15, 35-37, 44, 46-48, 55-57, 59-61, 68-74 and 81-83 is/are rejected.
- 7) ☒ Claim(s) 84-95 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 25.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 5-7, 15, 35, 36, 44, 46, 47, 55-57, 59, 60, 68-73 and 81-83 are rejected under 35 U.S.C. 102(b) as being anticipated by Yoon, 5,451,204. Yoon discloses a method of providing an ablation device including an expandable electrode array, see column 10, line 4, carried by an elongate tubular member and a pair of elongate flexures (branches 94 and their surrounding absorbent material 88) wherein each flexure includes at least one opening (96), the electrode array including a fluid permeable elastic member (88) having insulating regions and conductive regions thereon, see column 10, line 4; positioning the electrode array in contact with tissue to be ablated, see column 10, lines 5-6, and moving the array to an expanded condition by expanding the flexures, see column 9, lines 55-57; delivering RF energy through the

Art Unit: 1641

array to the tissue to cause the tissue to dehydrate, see column 10, lines 3-6; and during the step of delivering RF energy, see column 6, lines 13-15, applying suction through the fluid permeable elastic member to cause moisture generated during the dehydration to pass into the fluid permeable elastic member and away from the tissue and allowing at least a portion of the moisture to pass through the openings in the flexures, see column 9, lines 17-22.

As to claims 15, 35, 46, 59 and 72, Yoon teaches the step of applying suction to draw the moisture through the tubular member, see column 9, lines 17-22.

As to claims 36, 47, 60 and 73, Yoon teaches the step of causing the electrode array to conform to the shape of the tissue surface, see column 2, lines 1-12.

As to claim 44, 57, 70, 71 and 83, at least one of the flexures includes an electrically conductive region, see column 10, line 1, in contact with a conductive region of the electrode array, see column 10, lines 1-5.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 37, 48, 61 and 74, are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoon, 5,451,204, in view of Edwards et al., 5,507,743.

Yoon discloses the invention substantially as claimed, see above. However, Yoon does not disclose the step of monitoring impedance using the electrode array and automatically terminating the flow of current once impedance has approximately reached a predetermined level.

Edwards et al. discloses an RF treatment apparatus and teaches the step of calculating impedance and comparing impedance limits by microprocessor so that when the values exceed predetermined impedance values, the delivery of RF energy is reduced, modified, or interrupted, see column 8, lines 27-37.

Allowable Subject Matter

Claims 34, 38-43, 45, 49-54, 58, 62-67, 75-80 are allowed.

Claims 84-95 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed September 6, 2002 have been fully considered but they are not persuasive. With respect to the above rejected claims, Applicant argues that Yoon does not disclose drawing suction through the device during RF delivery, see page 12 of Applicant's response. This argument is not persuasive. Yoon not only teaches making the spine of electrically conductive material and use of an electrosurgical device for coagulation, see column 10, lines 1-5, but Yoon also teaches

Art Unit: 1641

applying suction for selective or continuous drainage or aspiration of fluids from operative site, see column 6, lines 13-15. Thus, it is understood that drainage may be continuously provided during operation of the device, i.e., during RF delivery for coagulation.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ann Y. Lam whose telephone number is (703) 306-5560. The examiner can normally be reached on M-Sat 11-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long V. Le can be reached on (703)305-3399. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Art Unit: 1641

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0196.

A.L.



LONG V. LE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

09/27/03